

REMARKS

The Examiner has rejected claims 1-12 under U.S.C. 102(b) as being anticipated by Knudson, U.S. Patent 5,845,432. The arguments presented in the previous office action are referenced.

Applicant has amended Claim 1 to differentiate the elements of the invention relative to the gutter. Examiner stated in the December 20, 2004, rejection that "Knudson discloses a bracket having a junction (Fig. 1: 43) a lifting strut (32) attached to the juncture, a stabilizing strut (39) attached to the juncture, and a bracing strut (65) attached to the juncture." The Examiner's rejection did not address the relative position of the struts in the gutter, and how they are connected. The medial position of the junction clearly differentiates applicant's invention from Knudson. In a mechanical invention, the relative position of the elements can be determinative as to the effectiveness of an invention. Take, for instance, a lever with a fulcrum. The same elements achieve vastly different results depending on the relative position of the fulcrum. In one position the tool has a mechanical advantage and in another position a mechanical disadvantage. As shown in all the figures of the disclosed invention, in each embodiment of the invented bracket the stabilizing strut has a hooked end and a medial end, where the medial end intersects with the junction (see page 5, line 14; page 8, line 14, page 12, line 12). The medial end (where medial, defined by Webster, is toward the middle) positions the junction substantially in the middle of the gutter. The stabilizing strut in Applicant's invention is shorter than Knudson's, which spans the full width of the gutter channel. Knudson's junction (Fig. 1: 43) is located as far away from the frontal rim as is possible, fastened to the rear wall with a nail 75. Applicant's invention requires no fastening element. Using the lever and fulcrum analogy, the Applicant's invention provides support for the cover and derives support from the frontal edge of the cover. Knudson's invention derives support from the fascia board. A second difference between Applicant's bracket and

Knudson's is that the element identified by the Examiner as being equivalent to the bracing strut, Knudson (65), is described on page 4, line 36, as an "indentation". Perhaps the Examiner meant 35, which on page 3, lines 3 - 5, is described as "a cantilever-type support for the shield, and a rear base portion 35 extends transverse to the rear end of the body portion 32 and bears against the back wall 18 of the gutter 12." Applicant's invention has no comparable element. The bracing strut bears against either the bottom of the gutter or the front wall or a combination, but in no case against the back wall. The structure of the junction and stabilizing strut preclude a cantilever support, and in contrast to Knudson's invention, which supports the gutter, Applicant's invention is supported by the gutter.

Claims 2-12 stand rejected. Claims 2-12 are dependent claims and have all the limitations of the parent claim, claim 1.

Claims 1 through 12 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by Knudson. As the Examiner is well aware, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987), *cited in*, M.P.E.P. § 2131. "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. M.P.E.P. § 2131, *citing*, In re Bond, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990). Thus, if any feature taught by the claimed invention is not taught by the reference cited by the Examiner, then the claimed invention and the reference are patentably distinct. In such a case, a 35 USC § 102 rejection is improper. As discussed above, the Knudson reference teaches elements not claimed in independent claim 1, or in the dependent claims 2-12. A partial recitation of elements not taught by Knudson are 1) a stabilizing strut having a distal hooked end that can interlock with a folded edge of a frontal rim of the gutter and having a medial end that is integral to the junction, and 2) at least one bracing strut having a distal lower end and an upper end

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that is integral with the junction, wherein the at least one bracing strut is angled so that the distal lower end will contact the bottom of the gutter or the front wall of the gutter or a combination. Knudson teaches a base, not a bracing strut, and Knudson teaches a stabilizing strut that supports the gutter, but does not stabilize the junction. Knudson's junction (43) is stabilized by a nail driven into the fascia board. As the Examiner is well aware, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987), *cited in*, M.P.E.P. § 2131. "The identical invention must be shown in as complete detail as is contained in the... claim." Richardson v. Suzuki Motor Co., 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. M.P.E.P. § 2131, *citing*, In re Bond, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990). Thus, if any feature taught by the claimed invention is not taught by the reference cited by the Examiner, then the claimed invention and the reference are patentably distinct. In such a case, a 35 USC § 102 rejection is improper.

Claims 13-15, and 18 are rejected under USC 1039a) as being unpatentable over 5,845,432 to Knudson, as stated in the previous office action.

Claim 13 (currently amended) reads, the bracket has a structure that lends itself to being formed by continuous extrusion, and cutting the bracket to the desired width. Examiner is well aware that if a bracket is to be continuously formed by extrusion, then it must be identical in the extruded axis. The advantage of a bracket with this symmetry is that savings can be realized in manufacture, and the width of the bracket can be custom cut. Applicant's invention meets this criteria. Knudson's invention does not. See Fig 9:147 and Fig 7:87. Furthermore, dependent claim 13 on depending on claim 1, has all the limitations of claim 1.

Claims 14, 15, and 18 depend on claim 13, which depends on claim 1. The dependent claims have all the limitations of the intervening claims.

Generally, "to establish *prima facie* obviousness of the claimed invention, all the cited limitations must be taught or suggested by the prior art". *In re Royka* 490 Fed. 2<sup>nd</sup> 981 (C.C.P.A., 1974). "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references." M.P.E.P. §2143.02, citing *Ex Parte Levengood*, 28 U.S.P.Q. 2<sup>nd</sup> 1300 (Bd. Pat. App., 1993). To date, the Examiner has provided absolutely no objective reasoning whatsoever to support the claim of obviousness relating to the above cited dependent Claims. Indeed, the Examiner has only stated that in Col. 3, lines 6-8, Knudson teaches that the bracket could be formed by extrusion, and admits that Knudson does not teach cutting. The Examiner, at the time of his objection, obviously did not appreciate the value of having a bracket that could be individually sized by cutting when he stated on page 5, line 14, that it would be obvious for one skilled in the art "to cut excessive flashing from the bracket." The value is not in finishing a bracket, but in eliminating the need for individual extrusion molds, and de-molding in general. Continuous extrusion solves all these issues. Knudson doesn't teach this, as discussed above.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desired validity of the combination. M.P.E.P. §2143.01; *In re Mills*, 1916 Fed. 2<sup>nd</sup> 680, 16 U.S.P.Q. 2<sup>nd</sup> 1430 (Fed. Cir. 1990). There must be some objective support. The Examiner has neither cited nor stated any fact that the cited reference suggests the desirability of continuous extrusion

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and cutting. In fact, the Examiner has indicated a process (e.g., cutting off excess flashing) that could be employed that is distinctly counterproductive to the desired end-result. The Examiner, furthermore, has admitted that Knudson does not teach cutting. As this rejection is clearly improper, reconsideration thereof is hereby requested.

Claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson in view of U.S. Patent 5,570,860 to Schoenherr. The arguments presented in the previous office action are referenced.

Claims 16 and 17 ultimately depend on claim 13, which depends on claim 1. The dependent claims have all the limitations of the intervening claims. Claims 1 and 13 have been exhaustively discussed, and because of the intervening limitations, claims 16 and 17 should be allowed. Furthermore, Schoenherr teaches a clip / bracket for hanging gutters, just like Knudson. Applicant's invention is not used to hang gutters, and has no elements that can be used to hang gutters. The reference would appear to be inappropriate as it is not suitable for fabrication using continuous extrusion, and there is no counter part to a stabilizing strut having a medial end. Neither Schoenherr nor Knudson teach a bracket suitable for attaching a cover to an existing gutter. The rejection is clearly improper, reconsideration thereof is hereby requested.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson. The Examiner states it would be obvious to extend the bracing strut downward far enough to contact the bottom of the gutter in order to increase the contacted surface area, and therefore provide stronger support for the gutter.

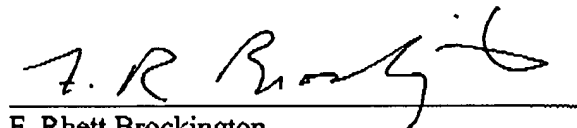
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Applicant reminds the Examiner that the invented bracket does not support the gutter. The gutter supports the bracket. The claim should be allowed as the grounds for rejection do not apply to the pending invention.

There have been no new claims added so there are no additional fees.

In view of the foregoing amendment and these remarks, this application is now believed to be in condition for allowance and such favorable action is respectfully requested on behalf of Applicant.

Respectfully submitted,



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